

REMARKS

Claims 1, 6-20 and 22-25 are pending, all of which have been amended either directly or indirectly. Specifically, claims 17-20 and 22-25 are rejected under 35 U.S.C. Section 101 as directed to non-statutory subject matter. Claims 1-4, 6-20 and 22-25 are rejected under 35 U.S.C. Section 103 over De Boor et al. (U.S. Patent 6,173,316), Nokia (Nokia 6160 Owner's Manual, published September 1998) in view of Silberfenig et al. (U.S. Patent Application Publication 2001/0041590) and Hawkins et al. (U.S. Patent 6,516,202).

In addition, some corrections have been made to the specification, one of which limits the definition of "computing readable medium" (see page 28) to overcome the rejection under 35 U.S.C. 101. Moreover, the title has been altered to more specifically describe the claimed invention.

For the record, the following criteria with respect to obviousness is urged. For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03. Clearly, taken individually, the tested references are inadequate to support a rejection under 35 U.S.C. § 103. However, consider them in combination.

The establishment of a *prima facie* case of obviousness based on a combination of references requires that any asserted combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose, MPEP § 2143.03. Other considerations also apply.

The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. 127 S. Ct. 1727 (2007)) to be "expansive and flexible" and "functional." However, the standard is not controlling, rather, the various noted factors only "can" or "might" be indicative of obviousness based on the facts. The Supreme Court in KSR enunciated the following principles:

"[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a

technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill....[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The Supreme Court while recognizing the need “to guard against slipping into the use of hindsight,” acknowledged the following principles:

[r]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in KSR stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S. 1043 (1984); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to

negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerisonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Supreme Court in KSR has also stated that:

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place.

Further, the Supreme Court states that:

The Court relied upon the corollary principle that when the prior art **teaches away** from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.

The Office Action (dated 7/15/08) recognized the void in De Boor of the convenient feature of “last call dialing” in a portable computing device. To fill this void, the Office Action urges Nokia. However consider the combination.

Nokia relates to a specific cell phone. De Boor relates to man-machine interfaces (col. 1, ln. 7). It is noted that De Boor refers to a Nokia 6100 (col. 8, ln. 31). The cited Nokia reference relates to a Nokia 6160.

However, in the De Boor system, telephone operations are attained by a “telephone protocol handler” (see col. 12, ln. 8). In view of the complexity of De Boor, and the considerable possibilities, it is submitted that the reference actually teaches away from the simplification of immediate simple return call dialing.

Another consideration, which teaches against a combination of the two references, involves the lack of plausible interrelationship between the combined references.

Application No.: 09/675,406
Reply to Office Action of: July 15, 2008

With respect to the mute button and note button operations, similar considerations apply. However, a strong consideration involves the number of references involved in the asserted combination.

The Office Action asserts a combination of four disparate references to meet the claims (De Boor, Nokia, Silberfenig and Hawkins). Such a combination by gleaned aspects from four different references strongly suggests exceeding the bounds of reasonable combination.

Reconsideration and favorable allowance of the claims here is respectfully requested.

Respectfully submitted,

BERRY & ASSOCIATES P.C.

Dated: October 15, 2008

By: /Byard G. Nilsson/
Byard G. Nilsson
Registration No. 17,350

9255 Sunset Blvd., Suite 810
Los Angeles, CA 90069
(310) 247-2860